

REMARKS

This is a full and timely response to the final Office Action of September 7, 2000. Upon entry of this Second Response, claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 remain pending in this application. Reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Response to §103 Rejections

The "fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). "(A)n applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application." *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Therefore, an applicant may overcome a rejection based on a patent "by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant." M.P.E.P. §2136.05; see also *In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand rejected under 35 U.S.C. §103 as purportedly being obvious to *Ross* in view of *Bolger*. However, for the reasons set forth in the First Response filed on July 31, 2000, Applicant asserts that the subject matter disclosed by *Ross* and

used reject the pending claims of the instant application was derived from Applicant. Thus, *Ross* is not a proper prior art reference, and the rejection to claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 should be withdrawn.

In rejecting the foregoing claims, it is asserted in the Office Action that:

Applicant, in citing *Applied Materials Inc. v. Gemini Research Corp.*, *In re DeBaun*, MPEP 2136.05 and *In re Mathews*, argued that "the fact that an application has named a different inventive entity (than) a patent does not necessarily make that patent prior art." The key word is "*necessarily*". Although, applicant's statement is true, it is not so at all times and in all situations. (Footnotes omitted).

Applicant agrees that the term "necessarily" implies that a patent having a different inventive entity may, at times, be used as prior art against an application. More specifically, the patent may be used as a prior art reference in instances when an applicant fails to show that the subject matter of the patent has been derived from applicant's own work and/or when the patent has been published for more than one year prior to the filing date of an Applicant's application. However, when an applicant shows that the subject matter of the patent has been derived from his own work, then (in the absence of a time bar) the subject matter should not be used against the applicant to reject his application, pursuant to the law set forth by *DeBaun*, *Mathews*, and M.P.E.P. §2136.05.

It is further asserted in the Office Action that:

In reference to *Applied Material Inc. v. Gemini Research*, the examiner agrees. *However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art.* In the present case, the present application (has a) filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

The situation in *In re DeBaun* *only applies to the same applicant for the patent and the application.* *By same applicant, it's meant the same inventive entity.* In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross. (Footnotes admitted).

Applicant recognizes that the law set forth by *Applied Material* and *DeBaun* cases may be applied in situations when a patent has an earlier U.S. filing date than an application and when a patent and an application have common inventorship. However, there is no requirement in the case law for an applicant to show that one of these conditions exists in order to remove a patent as a prior art reference pursuant to the foregoing cases.

Indeed, in the case of *In re Mathews*, Dewey filed a patent application for a time delay protective device for an electronic circuit. 161 U.S.P.Q. 276 (C.C.P.A. 1969). The patent application (which issued as U.S. Patent No. 3,105,920) included unclaimed subject matter derived from Mathews, who was a co-worker of Dewey. Later, Mathews filed a patent application pertaining to the unclaimed subject matter disclosed in the earlier filed Dewey patent. The Court found that the Dewey patent included a “*full* disclosure of the invention now claimed by Mathews.” *Id.* at 277. Because the subject matter derived by Mathews was not claimed in the Dewey patent, Mathews was not named as an inventor in the Dewey patent. However, the Court held that the Dewey patent could not be applied as a prior art reference against the Mathews application, “since Dewey derived his knowledge (of the relevant subject matter) from Mathews.” *Id.* at 278. Therefore, the Dewey patent was not considered to be a prior art reference to the Mathews patent application even though: (a) the Dewey patent was filed before the effective filing date of the Mathews patent application, and (b) Mathews was *not* an inventor in the Dewey patent (*i.e.*, the Dewey patent and the Mathews patent application properly named different inventive entities). Accordingly, there is no requirement that an applicant must establish that he is a named inventor of a prior patent to remove the patent as a prior art reference via an affidavit/declaration under 37 C.F.R. §1.132.

In fact, M.P.E.P. §2136.05 states that “(w)hen a prior U.S. patent is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date of the U.S. patent under 37 C.F.R. §1.131 or by submitting an affidavit or declaration under 37 C.F.R. §1.132 establishing that the relevant disclosure is applicant’s own work.” (Emphasis added). There is no requirement in M.P.E.P. §2136.05 for the applicant to be named as an inventor in the prior U.S. patent.

Furthermore, the Court of Customs and Patent Appeals has stated in the case of *In re Land and Rogers* that:

there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally “another” and (2) the filing date must be “before the invention * * * by the applicant * * *.” When the 102(e) reference patentee got knowledge of the applicant’s invention from him, as by being associated with him, * * * and *thereafter* describes it, he necessarily files the application *after* the applicant’s invention date and the patent as a “reference” does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. 151 U.S.P.Q. 621, 633 (1966); see, also, *Mathews* at 279.

Noting that there is no mention of a requirement in *Land* for an applicant to be named as an inventor in a prior patent to overcome the prior patent as a reference, Applicant submits that the arguments in the Office Action incorrectly focus on the “by another” requirement of 35 U.S.C. §102(e) instead of the “before the invention” requirement. In focusing on the “before the invention” requirement, the “proper subject of inquiry” is “*who* invented the subject matter disclosed by (the reference) which was relied on to support the rejection.” *Id.* at 633 n. 11; see, also, *DeBaun* at 935. More specifically, if it can be shown that Ross derived the relevant subject matter from the Applicant, then Ross is not the inventor of the relevant subject matter, and the filing date of any Ross patent that includes the relevant subject matter is necessarily after the date that Applicant invented the relevant subject matter. Therefore, the proper inquiry is not who first disclosed the subject matter but rather who invented the subject matter.

Consequently, to overcome a prior art reference under 35 U.S.C. §102(e), all that needs to be shown (in the absence of a time bar) is that the subject matter relied on by the Examiner to reject the applicant's patent application was derived from the applicant.

It is further alleged in the Office Action that:

As to In re Mathews, one major difference between the present application and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

Applicant respectfully traverses the assertion that the Applicant must show that he and Ross were co-workers to remove the Ross patents as prior art under 37 C.F.R. §1.132.

In this regard, to remove a prior art reference under 37 C.F.R. §1.132 in the absence of a time bar, it is only necessary to show that the named inventor of the prior patent derived his knowledge of the relevant subject matter from the applicant. The applicant and prior inventor being co-workers is only one scenario in which this may happen, and *Mathews* should not be interpreted as requiring evidence showing that the applicant was a co-worker of the named inventor of the prior patent. In fact, it is asserted in M.P.E.P. §2136.05 that:

when the unclaimed subject matter of a patent is applicant's own invention, applicant may overcome a *prima facie* case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and learned of applicant's invention from applicant. (Emphasis added).

Therefore, it is recognized by the M.P.E.P. that the applicant being a co-worker of the named inventor is only an *example* of a scenario in which the named inventor may be "associated" with an applicant so that the named inventor may derive subject matter from the applicant. Accordingly, Applicant

respectfully asserts that there are other scenarios in which the named inventor may derive subject matter from the applicant, and it is not necessary for the Applicant to submit evidence showing that the Applicant and Ross were co-workers to remove the Ross patents as prior art references pursuant to *In re Mathews*.

In addition, even though Applicant traverses the foregoing “co-worker” requirement, Applicant submits that the “co-worker” requirement is satisfied by the facts of the present case. In this regard, Exhibits A - F submitted along with the First Response filed on July 31, 2000, show that Applicant and Ross were attempting to form a business together and that Ross was responsible for raising money for the business. Therefore, Applicant submits that he and Ross were, in fact, “co-workers.”

It is also asserted in the Office Action that:

Applicant can (file) an affidavit to overcome the rejection. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee.

Applicant respectfully traverses the above conclusion and asserts that there is no basis in the case law for requiring the Applicant to show either of the foregoing contingencies. As set forth hereinabove, the law set forth in *Mathews* shows that an applicant does not have to be a named inventor of a patent to remove the patent as a prior art reference via a Declaration under 37 C.F.R. §1.132. Further, the verdict in *Mathews* does not appear to turn on whether or not the patent and the application are assigned to the same entity. Indeed, as set forth hereinabove, the rationale behind removing a patent as a prior art reference when the patent includes subject matter derived from an applicant is directed toward the fact that the applicant, not the named inventor of the patent, is the inventor of the relevant subject matter. See *Land* at 633 and *Mathews* at 278 in which the Court in *Mathews* specifically held that the applicant was the “the original, first, and sole inventor.” Further, whether or not an application

and a patent are assigned to the same entity is irrelevant in inventorship issues. Thus, whether or not Applicant and Ross have assigned their interest to the same entity should be irrelevant in determining whether or not Applicant's declarations may be considered to overcome *Ross* pursuant to the foregoing case law. As a result, the requirement in the Office Action for the Applicant to show either (1) that he is a named inventor of the Ross patent or (2) that the present application and the Ross patent are assigned to the same entity does not comport with the case law set forth hereinabove.

For the foregoing reasons, Applicant asserts that *Ross* is not a valid prior art reference to the instant application as alleged in the Office Action. Therefore, the rejection to pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is improper and should be withdrawn.

Response to Double Patenting Rejections

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497 and claims 1-36 of copending Application No. 09/163,958. Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35 and 36 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119. Applicant respectfully traverses these provisional rejections and asserts that the claims of the foregoing applications do not suggest each feature of pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. Noting that the foregoing rejections are provisional, Applicant requests that the rejections be withdrawn when the present application is otherwise in a condition for allowance pursuant to M.P.E.P. §823.

Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand rejected under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,623,260, claims 1-15 of U.S. Patent No. 5,657,010, and claims 1-80 of U.S. Patent No. 5,668,543. However, Applicant submits that the present application claims priority to copending Application No. 08/852,119. Further, Application No. 08/852,119 claims priority to U.S. Patent No. 5,623,260, U.S. Patent No. 5,657,010, and U.S. Patent No. 5,668,543. Therefore, pursuant to 35 U.S.C. §154, any patent that will issue from the present application will have a term that will not exceed any of the terms of the foregoing patents, and as a result, there should be no unjustified term extension on a "right to exclude" that is already granted in any of the aforementioned patents. As such, the double patenting rejections to the pending claims of the present application are improper, and Applicant respectfully requests that the double patenting rejections be withdrawn.

In the Office Action, it is asserted that:

Application asserts that "the present application claims priority to copending US application No. 08/852,119. Further, application No. 08/852,119 claims priority to U.S. Patent No. 5,623,260; 5,657,010, and 5,668,543." However, the record does not show such claim.

The record shows that the present application 09/163,958 claims priority, as a continuation-in-part, to US application No. 08/852,119. US Patent No. 5,623,260; 5,657,010; and 5,668, 543 are all continuation-in-part of US Patent No. 5,400,020. There is no relationship between US application 08/852,119 and the above mentioned US patents. However, if Applicant has documents (proof) to show otherwise, Applicant is (invited) to submit such for consideration since US application No. 08/852,119 is under appeal and is with the Board of Appeals.

Applicant submits herewith Exhibit A, which is a copy of the first page of Application No. 08/852,119, as filed, showing that Application No. 08/852,119 claims priority to earlier filed applications as asserted hereinabove. Applicant is in the process of reviewing the claim of priority status, as recognized by the Patent Office, for the present application and Application No. 08/852,119. If Applicant discovers any

errors in the records of the Patent Office, Applicant intends to take appropriate action to correct for such errors.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By:



Jon E. Holland
Reg. No. 41,077

100 Galleria Parkway, N.W.
Suite 1750
Atlanta, Georgia 30339
(770) 933-9500